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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,780	03/16/2001	Erica Ress	RESS/03	8794

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EXAMINER

HEWITT II, CALVIN L

ART UNIT PAPER NUMBER

3621

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/809,780

Applicant(s)

RESS ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Status of Claims

1. Claims 1-19 have been examined.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 12-15, 18 and 19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shear, U.S. Patent No. 5,410,598.

As per claims 1, 2, 15, 18 and 19, Shear teaches a method of distributing content comprising associating a password (or keyword) with a literary work (e.g. documents, sections, properties, publications, etc.) (column 4, lines 17-47; column/line 6/61-7/3; column 14, lines 60-68; column 15, lines 16-34; column/line 15/45-16/8; column/line 18/50-19/20), setting a predetermined access limit to the password (column 18, lines 50-55; column 19, lines 38-66), receiving the

password online and allowing a user to access the content if the limit hasn't been violated (column 18, lines 3-54).

As per claim 3, Shear teaches defining a plurality of passwords and associating or storing a password or keyword to or in a copy of a book (column/line 15/65-16/26).

As per claim 7, Shear teaches expiration dates, after which passwords expire and users are no longer able to access content (column/line 5/63-6/2; column 14, lines 38-50; column 15, lines 15-33)

As per claims 12 and 13, Shear teaches tracking on-line interaction with the content and transmitting statistical data to a classroom moderator, originator of the literary work or a third-party online content provider (column/line 13/65-14/5; column 15, lines 45-48; column 16, lines 1-26; column/line 18/55-19/38).

As per claim 14, Shear teaches defining a plurality of access classes and in response to a selection by a password holder of one of the classes limiting online access to the respective subset (column 15, lines 15-34 and 45-63).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4, 6, 8-10, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shear, U.S. Patent No. 5,410,598.

As per claim 4, Shear teaches a method of distributing electronically stored content comprising associating a password with a literary work and allowing users to access the work online (e.g. documents, sections, properties, publications, etc.) (column 4, lines 17-47; column/line 6/61-7/3; column 14, lines 60-68; column 15, lines 16-34; column/line 15/45-16/8; column/line 18/50-19/20; column 19, lines 38-65). To one of ordinary skill the literary work at least exists or existed at one time in physical form. Therefore, Shear provides access to the on-line portion of a "book", namely the book itself. The term "obsolete" is broad, as information can be rendered obsolete in a plurality of ways (e.g. more up-to-date information, new discoveries). Yet, to be "obsolete" does not necessarily mean "death" as technologies, companies, theories, people have been resurrected, and sometimes people are just wrong (e.g. AOL vs. Time Warner, e-mail vs. the telephone, "click" vs. brick and mortar companies).

As per claim 6, Shear teaches a method of distributing electronically stored content comprising associating a password with a literary work and allowing users to access the work online (e.g. documents, sections, properties, publications, etc.) (column 4, lines 17-47; column/line 6/61-7/3; column 14, lines

60-68; column 15, lines 16-34; column/line 15/45-16/8; column/line 18/50-19/20; column 19, lines 38-65). Regarding communicating between two users, the telephone and e-mail are well-known communication technologies for the exchange and discussion of ideas.

As per claim 8, Shear also teaches passwords with predetermined access limits such as passwords associated with a billing cycle (column 6, lines 36-50; column 14, lines 45-50; column 15, lines 16-45; column 16, lines 41-53). Specifically, Shear teaches expiration dates, after which passwords expire and users are no longer able to access content (column/line 5/63-6/2; column 14, lines 38-50; column 15, lines 15-33). Therefore, it is at least obvious that a user provides payment in order to continue using content.

As per claims 9 and 10, Shear teaches charging a fee for providing users with passwords to enable said users to access content (column 6, lines 36-50; column/line 15/16-16/26). Regarding "the sale of passwords", the business practice of outsourcing is old and well-known, therefore, it would have been obvious to one of ordinary skill to "contract out" or "outsource" the task of creating passwords in order to increase revenues.

As per claims 16 and 17, Shear teaches defining a plurality of passwords and associating or storing keywords (e.g. passwords, words) in a copy of a book (column/line 15/65-16/2) and allows users to search online news content using key words (figures 2 and 5; column/line 10/34-11/9; column 13, lines 54-68;

column/line 20/15-21/38). Shear also teaches providing content over a network (column/line 19/39-21/38). Therefore, it would have been obvious to one of ordinary skill to communicate content over a communications link (column 19, lines 39-45), such as the internet, using HTML (e.g. meta tags).

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shear, U.S. Patent No. 5,410,598 in view of Neville, U.S. Patent No. 6,272,636.

As per claim 5, Shear teaches a method of distributing electronically stored content comprising associating a password with a literary work and allowing users to access the work online (e.g. documents, sections, properties, publications, etc.) (column 4, lines 17-47; column/line 6/61-7/3; column 14, lines 60-68; column 15, lines 16-34; column/line 15/45-16/8; column/line 18/50-19/20; column 19, lines 38-65). However, Shear does not specifically recite allowing users access to content when a time limit has expired. Neville et al. teach a system for distributing content electronically by allowing users to sample a product before purchasing it (column/line 1/65-2/47; column 6, lines 45-65; column/line 13/12-14/15). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Shear and Neville et al. in order to provide a secure method for enabling content providers (e.g. publishers) to allow users to sample their product and after receiving payment, allowing users

unrestricted access to the content ('636, abstract) (Note: the term "unrestricted" is also broad).

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shear, U.S. Patent No. 5,410,598 in view of Hogan, U.S. Patent No. 5,692,132.

As per claim 11, Shear teaches a method of distributing electronically stored content comprising associating a password with a literary work and allowing users to access the work online (e.g. documents, sections, properties, publications, etc.) (column 4, lines 17-47; column/line 6/61-7/3; column 14, lines 60-68; column 15, lines 16-34; column/line 15/45-16/8; column/line 18/50-19/20; column 19, lines 38-65). Shear also teaches with passwords predetermined access limits such as passwords associated with a billing cycle (column 6, lines 36-50; column 15, lines 16-45; column 16, lines 41-53). However, Shear does not teach a explicitly recite a user method for paying for said content. Hogan teaches a system for cashless transactions over a network (figure 1; abstract) comprising debiting an account stored in computer memory (abstract). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Shear and Hogan in order to provide users with a secure and efficient method for paying for content over a network ('598, abstract; figures 3-4b; '132, figures 5A-B; column/line 2/34-3/18).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Darago et al. teach a method and system for providing users with online access to content
- Schull teaches protecting portions of distributed content using passwords
- Ananda teaches software rental with password verification

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

Art Unit: 3621

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:


(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Calvin Loyd Hewitt II

April 25, 2004



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600